

REMARKS

The Official Action of March 3, 2009, and the prior art relied upon therein have been carefully reviewed. Claims 1-8 and 12-17 are now in the application, including currently withdrawn claims 13-17. Applicants' claims define patentable subject matter as pointed out below, and therefore should be allowed. Accordingly, favorable reconsideration and allowance are respectfully urged.

Acknowledgement by the PTO of the receipt of applicants' papers filed under §119 is noted.

Applicants also note the commentary regarding the restriction requirement and rejoinder at pages 2-6 of the Office Action. It is respectfully noted that claims 13-17 are **not** directed to methods of use as stated at the bottom of page 2 of the Office Action: these claims are essentially composition claims, although the preamble of each such claims does not recite the term "composition".<sup>1</sup> These claims 13-17 all depend directly or ultimately from claim 1, and thus incorporate the subject matter of claim 1, and hence meet the requirements for rejoinder. Applicants accordingly

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<sup>1</sup> Applicants respectfully note that in compound, composition and product claims, the PTO invariable refuses to give weight to an intended use. Accordingly, the fact that these claims recite intended uses should not prevent rejoinder.

respectfully request rejoining of claims 13-17, and allowance thereof all along with allowable claim 1.

By the amendments presented above, claim 1 has been amended to correspond with elected Group III, without prejudice and to advance prosecution. Such amendments are not to be taken, however, as any abandonment of any subject matter previously encompassed by claim 1, the applicants reserving their right to pursue such subject matter in one or more divisional applications, relying on §§121, 120 and 119.

In connection with the amendment of claim 1, claim 7 has also been revised and claims 9-11 have been cancelled.

Certain other amendments have also been made. Thus, the definition of  $R_{10}$  in claim 1 has been deleted.

The recitations relating to the term "prodrug" have been deleted. In claim 1 " $C_{1-6}$ alkyl" has been deleted from the definition of Y. In this connection, claims 5 and 6 have also been revised. The indications "[Formula 1]", "[Formula 2]" and "[Formula 3]" have been deleted.

Claims 1-12 have been rejected under the first paragraph of §112, it being the examiner's position that these claims fail to comply with the written description requirement. This rejection is respectfully traversed.

As indicated above, the claims have been amended to delete reference to prodrugs. The Office Action states that this rejection would be overcome by such an amendment, and so it is understood that this rejection will be withdrawn, and applicants are proceeding in reliance thereof.

For the record, however, applicants reserve the right to pursue prodrugs in a continuing application at a later date, if applicants choose to do so, without any penalty whatsoever, and in which case applicants would rely on §§120 and 119.

Claims 1-12 have been rejected under the second paragraph of §112 as being allegedly indefinite. The rejection is respectfully traversed.

The issue regarding the word "prodrug" is discussed above, and should no longer be an issue.

As regards the other objections, appropriate amendments have been made in deference to the examiner's views, these other amendments being clearly cosmetic, without any change in scope of the claims.

As stated in the rejection, the amendments made above should obviate this rejection, and applicants are proceeding in reliance thereof.

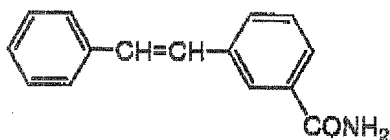
Claims 1-12 have been rejected as anticipated by either and both of Heesemann (U) and Huth et al, WO 2001/081311 (Huth). Applicants respectfully note that Huth, written in German, corresponds to a Canadian publication in English, namely CA2406392, copy attached. These rejections are respectfully traversed.

As understood, both these rejections are based on the references disclosing compounds which are alleged to be prodrugs of applicants' compounds. Whether or not such compounds of the prior art are prodrugs of any of applicants' compounds, the prodrugs are no longer claimed.

Withdrawal of the rejections is therefore in order and is respectfully requested.

Claims 1-12 have been rejected under §103 as obvious from Matsumura, reference V. This rejection is respectfully traversed.

Matsumura discloses 3-stylyl-bennzamide represented by the following formula:



The rejection states that one of ordinary skill in the art would have known to replace H with alkyl at the time the

present invention was made, and therefore the invention claimed is *prima facie* obvious from the teaching of Matsumura.

Applicants respectfully disagree. The prior art provides no reason why one of ordinary skill in the art would have wanted to do the alleged replacement, or would even have thought to make such a substitution. In the absence of any reason for making such a substitution, it would not have been obvious to do so.

Moreover, the prior art gives no hint as to which hydrogen should be replaced, even if the thought of replacing a hydrogen atom would have occurred to the person of ordinary skill in the art. In this regard, it should be noted that the citation relates to reactions of 4-styryl-tropolone and discloses compounds obtained by the reactions, but does not include any descriptions regarding pharmacological effects of the compounds. Thus, and again, no reason exists for any such substitution.

However, to expedite examination of this application, applicants have deleted "C<sub>1-6</sub>alkyl" from the definition of "Y" in amended claim 1. Therefore, the basis for the rejection, even if such basis were correct, no longer exists. Accordingly, it is clear that the rejection should be withdrawn.

For the record, the amendment referred to immediately above is made without prejudice to applicants'

rights to pursue broader claims in a continuing application, if applicants choose to do so, without any penalty whatsoever, applicants in such a case relying on §§119 and 120.

It should be added that, contrary to Matsumura, which discloses no pharmacological effects of the compounds there disclosed, applicants' compounds have an angiogenesis inhibitory effect, which is advantageous for treatment or prevention of cancerous diseases. Therefore, even in light of Matsumura, applicants respectfully submit that no person skilled in the art would conceive of the compounds of the present invention having such advantageous effects in any way.

Withdrawal of the rejection is in order and is respectfully requested.

The prior art documents of record and not relied upon by the PTO have been noted, along with the implication that such documents are deemed by the PTO to be insufficiently material to warrant their application against any of applicants' claims.

Applicants believe that all issues raised in the Official Action have been addressed above in a manner that should lead to patentability of the present application.

Appln. No. 10/584,233  
Amendment dated June 3, 2009  
Reply to Office Action dated March 3, 2009

Favorable reconsideration and allowance are respectfully  
requested.

Respectfully submitted,

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